

## **REMARKS**

### **Summary**

Claims 32-53 were pending and all of the claims were rejected in the Office action. Claims 32, 42, 46-47, 49-50 and 52 have been amended; Claim 33 has been cancelled. No new matter has been introduced. Claims 32-53 are pending after entry of this amendment. The Applicants have carefully considered the references and reasons advanced by the Examiner and respectfully traverse the rejections in view of the amendments and of the discussion presented below.

### **Claim Rejections**

#### **35 U.S.C. § 112, second paragraph**

Claim 32 was rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended Claim 32 to better describe the relationship of the surfaces and respectfully submit that this has overcome the rejection.

Claim 33 was rejected as indefinite. The Applicants have adopted the Examiner's suggested clarification, and respectfully submit that the amendment to the text of Claim 33 has thus overcome the rejection. Note that the substance of Claim 33 has been incorporated into Claim 32, and that Claim 33 has been cancelled.

Claims 47 and 50 were rejected as lacking proper antecedent basis for the limitation "the lens". This is a further consequence of an error in claim numbering made in the parent application. Claims 47 and 50 have been amended to be dependent on Claims 46 and 49 respectively, so that this error has now been corrected.

The specification has been amended so that it incorporates an amendment made to the parent application.

The Applicants respectfully submit that the amendments to Claims 32, 33 (as incorporated into Claim 32), 47 and 50 have overcome the rejections under 35 U.S.C. § 112, ¶ 2.

**35 U.S.C. § 102 (b)**

Claims 32, 34-37, 39-40, 43, 45, 47-48 and 50 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Miura et al. (US 5,966,499; "Miura").

Claim 32 has been amended to incorporate the subject matter of Claim 33, which has been cancelled. Since Claim 33 was not rejected as being anticipated by Miura, the addition of the subject matter of Claim 33 to that of Claim 32 overcomes the rejection of Claim 32 under 35 U.S.C. § 102 (b). Claims 42, 46, 49, and 52 have been amended to be dependent on Claim 32.

Claims 34-53 are dependent on Claim 32, and are allowable providing that Claim 32 is allowable, which we shall argue below.

**35 U.S.C. § 103 (a)**

Claims 33, 42, 46, 49 and 51-53 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Miura in view of Verdiell et al. (US 5,870,417; "Verdiell").

Claim 32 now includes all of the limitations of cancelled Claim 33, and recites, *inter alia*, positioning a lens on the first and second inclined surfaces such that a part of the lens protrudes in the second groove portion.

This has an advantage of enabling a high-NA lens to be positioned close to the optical element.

The Examiner acknowledges that Miura does not teach a lens positioned in grooves as in the arrangement of Claim 1 (Office action, page 5, second paragraph).

Verdiell, which is cited in an effort to remedy this deficiency in the *prima facie* case, is directed towards a DBR laser which, in an embodiment, includes a semiconductor gain element, and a fiber having a Bragg grating formed therein, with a means for efficiently coupling the semiconductor gain element to the fiber. The means is disclosed as a conical lens, a concaved cylinder, or wedge shaped element formed directly on or spliced to the fiber (Verdiell, col. 4, lines 26-37). So, according to Verdiell, the means does not exist separately as a lens; it is an integral part of the fiber and there is no suggestion that a separate lens can be used to perform the function required by Miura. The suggestion to use a separate lens arises only from the teaching of the present application, and it is improper to read the teaching of the present application into the prior art.

Also, assuming, *arguendo*, that a fiber with a lens end as taught by Verdiell is placed in a first groove as taught by Miura. There is no teaching, suggestion or motivation in either reference for the lens end of the fiber to extend into a second groove, or in fact for a second groove to be present at all. As the diameter of the lens end of the fiber is commensurate with the remainder of the fiber, none of the motivation necessary to reach the arrangement of Claim 1 is present in either of the references. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, Appeal No. 1998-2142 Page 8 Application No. 08/125,189 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

For at least these reasons, the Applicants respectfully submit that a *prima facie* case of obviousness with respect to Claim 32 has not been made out and that the claim

should be allowed. Claims 34-53, being dependent on and further limiting an allowable base claim are, without more, allowable.

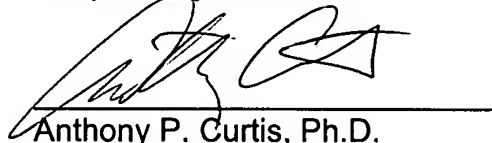
**Conclusion**

Claims 32, 42, 46-47, 49-50 and 52 have been amended; Claim 33 has been cancelled. Claims 32 and 34-53 are now pending.

In view of the amendments and for at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

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